

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

In item 12 on page 1 of the Action, the Examiner has failed to acknowledge the claim for foreign priority, and has failed to acknowledge that all certified copies of the priority documents have been received. Acknowledgement is respectfully solicited.

Claims 1-14 and 18-20 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement for the reasons set forth.

In addition, claims 1-14 and 18-20 are rejected under 35 USC 112, first paragraph, on the basis that the specification is lacking enablement for the reasons set forth.

Furthermore, claims 1-14 and 18-20 are rejected under 35 USC 112, second paragraph, as being indefinite for the reasons set forth.

(1) The term "hydrocarbon group" is amended based on the description on page 6, lines 18-25 in the specification.

(2) The term "prodrug" is deleted from claims 11, 13 and 18-20, and claim 2 is deleted.

(3) "N" is amended in claim 1 to "n".

(4) The "Het" in claim 3 is clarified.

(5) Claims 12 and 14 are deleted.

(6) Claim 13 has been amended to require a carrier in conformance with U.S. practice.

Support is found at page 54, last line.

In view of the foregoing, it is believed that each ground of rejection set forth under 35 USC 112, first and second paragraphs, has been overcome.

The foregoing amendments are effected without prejudice to the filing of a divisional application thereto.

Claims 1-14 and 18-20 are rejected under 35 USC 102 as anticipated by WO 02/053547. This ground of rejection is respectfully traversed.

The compound of the present invention, i.e., a compound wherein " $-\text{CH}(\text{R}^7\text{R}^8)-\text{C}(\text{R}^5\text{R}^6)-\text{COR}^3$ " is bonded to the benzene ring at the p-position, and " $-(\text{CH}_2)_n\text{-Het}$ " is bonded to the benzene ring, is not specifically disclosed in WO 02/053547.

Accordingly, the cited reference fails to anticipate the claims under 35 USC 102.

In addition, the superiority of the compound of the present invention is shown in the enclosed Declaration under 37 CFR §1.132. That is, the data indicates that a compound wherein “-CH₂-Het” is bonded to the benzene ring has a superior GPR40 agonist activity than a compound wherein “-CH₂O-Het” is bonded to the benzene ring.

Favorable reconsideration and withdrawal of this rejection is solicited.

Claims 1-14 and 18-20 are rejected under 35 USC 103 as unpatentable over WO 02/053547 and U.S. 2006/0004012. This ground of rejection is respectfully traversed.

The Examiner holds that the compound of the present invention can be obtained by substituting the methoxy group of compound 14.4-14.5 with a Het ring of compound 10.8-10.13. However, it is respectfully submitted that the holding of the Examiner is incorrect, since “-(CH₂)_n-” (not -CH₂O-) is bonded to the benzene ring in the present compound.


Accordingly, it is respectfully submitted that this ground of rejection should be withdrawn.

Lastly, claims 1-14 and 18-20 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-18 of co-pending application No. 10/584,730.

The Examiner is respectfully requested to hold this ground of rejection in abeyance. Upon overcoming all other grounds of rejection, it is respectfully submitted that this provisional ground of rejection should be withdrawn.

In view of the foregoing, it is believed that each ground of rejection set forth in the Official Action has been overcome, and that the application should be placed in condition for allowance. Accordingly, such allowance is solicited.

Respectfully submitted,
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